

**REMARKS**

The present Office Action rejects pending Claims 1-17 and 20 under 35 U.S.C. § 103(a). The present Office Action objected to claims 18 and 19 as being dependent upon a rejected claim, but stated claims 18 and 19 would be allowable if rewritten in independent form including the base claim and all intervening claims.

By the preceding amendments, claim 18 has been rewritten in independent form and new claim 21 has been added. Thus, claims 18, 19 and 21 are pending in this application. Claims 1 through 21 are all believed to be in condition for allowance. Further and favorable reconsideration of the application is accordingly and respectfully solicited.

Generally, the present invention as set forth in the pending claims relates to a note taking organizational kit including at least one note board apparatus having a support board, a notepad assembly attached to the support board, and a clip element connected to the support board along an edge thereof. The clip element is configured to releasably connect the support board to an object. A storage unit may also be included that is configured to receive at least one note board apparatus within its interior. At least one divider may also be included, which may also be received within the storage unit and is configured to separate two or more note board apparatus. The divider may include an upwardly extending top edge configured to have a label connected thereon.

Response to 4-26-04 Office Action  
Serial No. 10/707,906  
Page 6

Allowable Subject Matter:

The Office Action states that claims 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims. Claim 18 has been rewritten to include the limitations of claim 14 and claim 19 depends from claim 18. Therefore, Applicant believes claims 18 and 19 are now in condition of allowance and respectfully requests that the objection of claims 18 and 19 be removed.

New Claim:

New claim 21 has been added and includes a note taking organizational kit having at least two note board apparatus having a support board, a notepad assembly attached to the support board and a clip element connected to the support board and configured to releasably connect the support board to an object. A storage unit is also included and is configured to receive the at least two note board apparatus within its interior.

As stated in the present Office Action, the Barron reference is designed to hold a single note board apparatus, whereas new claim 21 includes at least two note board apparatus. Further, none of the other cited references include all of the limitations of new claim 21, either alone or in combination. Therefore, Applicant submits that new claim 21 is patentable and requests allowance of said claim.

Response to 04-26-04 Office Action  
Serial No. 10/707,906  
Page 7

Rejection of Claims 1-7, 9, 10, 12 and 13 under 35 U.S.C. 103(b):

The Office Action rejects claims 1-7, 9, 10, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Lai (5,430,965) in view of Morrissey (5,607,067). Specifically, the Office Action states that Lai discloses a device comprising a writing board having removable fasteners (suction cups) along an edge, and that even though the fasteners are not clips, that clips are a well known attachment means and would have been an obvious variation on the suction cups. The Office Action further states that Lai does not disclose the notepad attached to a support board, but that Morrissey discloses a device comprising a support board which is removably attachable to an object and a notepad attached to the support board. The Office Action states it would have been obvious to one skilled in the art to modify the device of Lai as viewed in combination with Morrissey.

Lai discloses a message board that can be attached to a surface with suction cups. As disclosed in Lai, the message board is configured to attach to an object such as a car windshield or refrigerator, providing for the user to write messages directly on the message board surface, and does not provide a separate notepad. Morrissey discloses a notepad and a notepad holder that can be attached to an object with a hook and loop attachment, requiring one part of the hook and loop attachment to be affixed to the holder and the mating part to be affixed to the object.

The present invention provides a unique notepad assembly that is transportable and attachable to portions of a book or similar type of object. As required in independent claims 1 and 9, a clip element is connected to the support board and is

Response to 4-26-04 Office Action  
Serial No. 10/707,906  
Page 8

configured to releasably connect the support board to an object. The suction cups used to attach the message board in Lai have limited application and would be incapable of functioning in the same manner as the clip element of the present invention. For example, the clip element of the present invention allows for the support board to be attachable to a book by sandwiching pages or an edge of the book within the clip element. Whereas the suction cup fasteners of Lai would clearly not allow for this type of attachment. In order for suction cups to function properly, a specific type of surface is required, such as a metal or hard plastic surface, limiting its usefulness. Therefore, Applicant submits that the clip element of the present invention is not an obvious variation of the suction cups of Lai. Further Lai does not provide a notepad attached to a support board, rather Lai discloses only a board to write directly thereon.

While Morrissey provides a notepad and notepad holder, it does not provide a notepad attached to a support board and a clip element to releasably attach the support board to an object as required in claims 1 and 9 of the present invention. The notepad of Morrissey is slidably received within a pocket on the notepad holder and the notepad holder is releasably attachable to an object with a hook and loop attachment. The hook and loop attachment of the holder requires that one part of the hook and loop attachment be affixed to the holder and the mating part be affixed directly to the surface to which the holder is to be attached. Thus, only the notepad of Morrissey is transportable, as the holder is releasably attachable to a single designated object with the hook and loop attachment. Whereas with the present invention, the notepad is

Response to 04-26-04 Office Action  
Serial No. 10/707,908  
Page 9

attached to the support board and together the assembly is transportable to be used and attached to different objects.

In addition, there is no suggestion or motivation in either Lai or Morrissey to combine the notepad and support board of Morrissey with the message board of Morrissey. Therefore, Applicant respectfully submits that for the reasons set forth above, examiner has not met the burden of establishing a *prima facie* case of obviousness as required by the Manual of Patent Examiners (MPEP). The MPEP Section 2142 states the burden for establishing a *prima facie* case of obviousness as follows:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

There is no suggestion or motivation within the prior art of record to combine the references. Furthermore, neither of the references, alone or in combination, suggest or teach all claim limitations. Accordingly, Applicant submits that independent claims 1 and 9 are patentable for the reasons set forth above, as are the claims that depend from these claims (claims 2-8 and claims 10-13). Applicant respectfully requests that the rejection of claims 1-13 under 35 U.S.C. § 103(a) be removed.

Response to 4-26-04 Office Action  
Serial No. 10/707,906  
Page 10

Rejection of Claims 8 and 11 under 35 U.S.C. § 103(a):

The Office action rejects claims 8 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Lai in view of Morrissey, and further in view of Lopez (6,682,352).

For the reasons set forth previously, independent claims 1 and 9 are believed to be patentable, therefore since claim 8 depends from claim 1, and claim 11 depends from claim 9, Applicant submits both of these claims are also patentable. Applicant respectfully requests that the rejection of claims 8 and 11 under 35 U.S.C. § 103(a) be removed.

Rejection of Claims 14-17 and 20 under 35 U.S.C. § 103(a):

The Office action rejects claims 14-17 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Lai in view of Morrissey, and further in view of Barron (6,672,622). Specifically, the Office Action states that Lai as viewed in combination with Morrissey discloses all of the limitations of these claims except for the storage unit and that Barron discloses a device comprising a support board for a notepad and a storage unit configured to receive the notepad within its interior. The Office Action further states that it would have been obvious to one skilled in the art to modify the device of Lai as viewed in combination with Morrissey by providing a storage unit to protect the notepad.

Barron discloses a protective notepad holder having a tray structure and a covering structure configured to cooperatively engage each other and hold a notepad within its interior. The notepad holder of Barron is designed to hold a single notepad and protect it from water or other outdoor elements.

Response to 04-26-04 Office Action  
Serial No. 10/707,906  
Page 11

As discussed previously, neither Lai nor Morrissey, alone or in combination, disclose a note board apparatus having a support board, a notepad assembly attached to the support board and a clip element connected to the support board along an edge thereof and configured to connect the support board to an object as required in independent claim 14. Further, as stated in the Office Action, neither Lai nor Morrissey disclose a storage unit configured to receive a note board apparatus within its interior as further required by claim 14. In addition, although Barron discloses a holder configured to receive a single notepad, the three cited references do not disclose all of the required limitations of claim 14, alone or in combination. Further there is no suggestion or motivation to combine the three cited references. Accordingly, the burden of establishing a prima facie case of obviousness has not been established per MPEP Section 2142 as stated above. For the reasons set forth above, Applicant respectfully submits that independent claim 14 is patentable, as are the claims that depend from claim 14 (15-17 and 20). Applicant requests that the rejection of claims 14-17 and 20 under 35 U.S.C. § 103(a) be removed.

Response to 4-26-04 Office Action  
Serial No. 10/707,906  
Page 12

### Conclusion

Applicant appreciates allowance of claims 18 and 19 as rewritten in independent form and submits that independent claims 1, 9 and 14 and new claim 21 are patentable for the reasons set forth above, as are the claims which depend from these claims (dependent claims 2-8, 10-13, 15-17 and 20). Accordingly, Applicant respectfully requests all rejections be withdrawn, and that all pending claims 1-21 be allowed.

In light of the foregoing, Applicant respectfully submits that each item set forth in the Office Action dated April 26, 2004 has been addressed. In the event any further matters requiring attention are noted by the Examiner, or in the event that prosecution of this application can otherwise be advanced thereby, a telephone call to Applicant's undersigned representative at the number shown below is invited.

You are authorized to charge any fees due or credit any overpayment to Foster, Swift, Collins & Smith, P.C.'s Deposit Account No. 502197.

Respectfully submitted,

Dated: July 26, 2004

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Response to 04-26-04 Office Action  
Serial No. 10/707,906  
Page 13